

## **REMARKS**

The claims in this case have been rejected as being either anticipated by Nemirofsky et al., U.S. Patent No. 5,761,601, hereinafter referred to as “Nemirofsky” (claims 1-4, 6, 8, 9) or as being unpatentable as being obvious under 35 U.S.C. §103(a) over the combination of Nemirofsky and Khusheim et al., U.S. Patent Publication 2003/0221191, hereinafter referred to as “Khusheim” (claim 5), or rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Nemirofsky and Matthews et al., U.S. Patent RE38,376, hereinafter referred to as “Matthews” (claim 7).

### **Section 102 Rejection**

The claimed invention is fundamentally different than the cited Nemirofsky reference; however, the language of the reference and the claims can lead, mistakenly, to the conclusion that they are similar. The Examiner has clearly decided, mistakenly based upon the words used by the reference, that they are similar enough to allow a Section 102(b) rejection.

Considering first the claimed invention, it is perhaps best understood by looking at Figure 3 of the drawings where a “message”, comprising five time slots, is shown. In slot 1, there is only one choice of “segment”, that is, shot 1. In time slot 2, there are four possible video “segments” which can be used, the four segments being interchangeable within slot 2. In time slot 3, only one segment, shot 3, is available; however, in time slot 4 there are two segment shots, labeled 4A and 4B, available. Finally, in time slot 5 there are three available segments, labeled shot 5A, shot 5B and shot 5C. As with the shots in time slot 2, the shots in time slot 4 are interchangeable, as are the shots in time slot 5. With this array or matrix of video segments, the actual message which is created from these segments can take one of 24 ( $1 \times 4 \times 1 \times 2 \times 3 = 24$ ) possible configurations, or messages. It is the combination of these segments which form the message, that is, the message has 5 time slots filled by varying combinations of segments. On the same sheet of drawings, in Figure 4, a more complex combination of segments is illustrated and described in the Specification.

In the claimed invention, therefore, the “creation of a plurality of different messages to targeted audiences” is the same as saying, in relation to Figure 3, that there are 24 different messages which can be created and sent to different audiences. The segments then make up a

message, and the message is created by taking segments for each time slot and combining them, for example on the fly, and sending them to the intended targeted audience. The segments, in accordance with the claims, have associated with them assembly information, and the method provides in the assembly information the “how” of what to do with a plurality of the media segments in order to create the different messages for the targeted audience.

Claim 2 adds another critical element of the invention to those of claim 1. In claim 2, there is described that the actual assembled message is assembled after the segments are sent to storage at, for example, an upstream location, and prior to assembly of the “message.” The message is assembled once the information regarding the targeted audience has become available and it is assembled based on the assembly information provided with and associated with the plurality of media segments.

This is different than the video distribution system provided by Nemirofsky. As best understood, the Nemirofsky system is probably best described, in a succinct sentence, as noted in Column 5, lines 14-18, text previously used by the Examiner in his rejection. Unfortunately, there is no drawing in Nemirofsky which describes this insertion approach, however what appears to occur is that the system identifies a channel, or other identification of a “segment” which will be inserted into an ongoing broadcast program and that this can be performed, in particular, at the local site, that is, at a store or other kind of retail establishment. What is most important here, is that the segment that is to be inserted by Nemirofsky to form the message, is preformed, that is, segments are already preformed prior to any delivery to the local or retail establishment and it is the insertion of a preformed segment, as a whole, into the “general, network-wide program” to form a message, which is apparently the crux of the Nemirofsky system. Thus, it is the stored and pre-formed “segment” which is inserted, that is labeled a segment as defined in Nemirofsky, that is, a segment 22. There is no combination of video shots (applicants’ segments) as required by the claims, based on audience characteristics. That is, a preformed Nemirofsky segment is inserted into an available location of the program. And when it is inserted, it occupies the whole available “hole” in the network-wide program. Those “segments” are already created and stored when a decision of which “segment” to insert into the Nemirofsky “hole” is made. The segments are thus selected based on a desired audience, but the Nemirofsky “segments” are created specifically for that audience in advance, and not from a plurality of smaller elements (“segments” in Applicants’ claims) as defined and described in Applicants’ specification.

Accordingly, therefore, referring to claim 1, while Nemirofsky can provide a plurality of different messages to specific targeted audiences, the message portions to be inserted are not composed of a plurality of applicants' (media) segments, but rather one Nemirofsky segment. The message is not assembled in a manner so that at least one media segment is interchangeable with another one of the media segments (noting that these may be better termed "sub-segments" of a message for the purpose of understanding better what the claim requires), and assembly information regarding how the plurality of media segments are to be assembled (for example, as illustrated in Figure 14), is associated with the plurality of media segments (what I have here also called "sub-segments")

Accordingly, Nemirofsky does not anticipate claim 1, or any of the claims dependent upon it. It is urged that the basis of the Section 102(b) rejection is due to language in Nemirofsky which, unfortunately, does not have the same meaning in the patent as in the present application. Because of this, the Nemirofsky reference does not meet the terms of claim 1, and claim 1 should be found to be patentable over that reference. Further, all of the other claims depend upon claim 1 and should be found patentable for the same reason.

In addition, however, other of the claims are independently patentable. For example, claim 2 requires that the message be assembled based on the assembly information, the plurality of media segments, as well as on the information regarding the target audience. This assembly process of the plurality of media segments forming a message, is not found in Nemirofsky. Further, in view of the differences between the claims, the remaining claims rejected under 35 U.S.C. §102(b) should be found patentable, since in the context of the claimed invention, Nemirofsky does not provide the "sub-segments" which necessarily are required to complete the invention.

Finally, the Khusheim and Matthews references cited against claims 5 and 7 respectively, do not cure the defects of Nemirofsky which is further directed to a system that does not have "interchangeable segments".

For the reasons submitted above, it is respectfully submitted that the claims are patentable over the cited references, and that the application should be passed to issue in due course.

### CONCLUSION

All issues raised in the Office Action are considered to have been addressed. In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and reexamination of the present application are therefore earnestly solicited. The Commissioner is authorized to charge any fee arising in connection with the filing of this paper, including any necessary extension of time, to the deposit account of **K&L Gates LLP**, Deposit Account No. **0080570**. The Examiner is cordially invited to telephone the undersigned if any issue or question arises with respect to the present application.

Respectfully submitted

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